

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

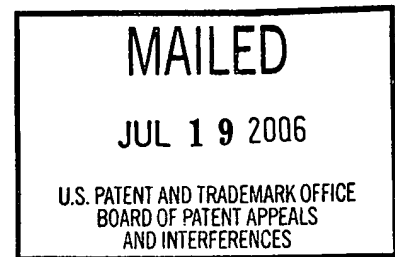
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEOFFREY B. RHOADS, WILLIAM C. HEIN III,
BRUCE L. DAVIS, BRIAN T. MACINTOSH and
KENNETH L. LEVY

Appeal No. 2006-1722
Application No. 09/547,664

ON BRIEF



Before KRASS, BLANKENSHIP, and MACDONALD, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 7-16.

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The invention pertains to linking objects to remote resources. For example, an imperceptible code may be embedded in a print media, e.g., a magazine advertisement. When this code is recognized by a suitably enabled PC camera, that code automatically directs an associated web browser to a destination chosen by the producer of the print media. The destination, e.g., a web page, may then provide additional, more-timely and/or more extensive, information.

Representative independent claim 13 is reproduced as follows:

13. A networked computer system, responsive to watermark data sent from a remote client application to initiate delivery of audio or video data.

The examiner relies on the following references:

Monteiro et al. (Montiero)	5,778,187	Jul. 07, 1998
Moskowitz et al (Moskowitz)	5,822,432	Oct. 13, 1998
Doyle et al. (Doyle)	5,838,906	Nov. 17, 1998

Claims 13 and 14 stand rejected under 35 U.S.C. § 102(e) as anticipated by Moskowitz.

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Claims 7-12, 15, and 16 stand rejected under 35 U.S.C.

§ 103. As evidence of obviousness, the examiner cites Doyle and Moskowitz with regard to claims 7-12, and Monteiro and Moskowitz with regard to claims 15 and 16.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

A rejection for anticipation under section 102 requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

With regard to instant claim 13, the examiner points to column 9, lines 17-40, of Moskowitz for a teaching the sending of watermark data, such as service agreements, to a remote computer for initiating data delivery or content downloading from the remote computer to the client via a network.

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Appellants take the view that Moskowitz does not use the watermark to *initiate* content delivery, but, rather, uses the watermark information to signal that a certain amount of content has been sent. In fact, appellants cite part of the same portion of Moskowitz (column 9, lines 19-26) to make the point that Moskowitz uses the watermark to make a decision whether to *discontinue* content delivery, not to *initiate* content delivery. (See page 11 of the reply brief).

We have reviewed the evidence before us, including, *inter alia*, the arguments of appellants and the examiner and the disclosure of Moskowitz and we conclude therefrom that the examiner has established a *prima facie* case of anticipation that has not been successfully rebutted by appellants.

While we understand the distinction appellants are attempting to make in the use of the watermark in Moskowitz to determine whether to continue data content that has already begun to be delivered, rather than to start delivery of the content, it is our view that "initiate" can be interpreted a bit more broadly. Webster's Ninth New Collegiate Dictionary, 1985, defines the term as "to cause or facilitate the beginning of."

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Now, it does appear from column 9 of Moskowitz that data content has already begun (the "sender agrees they have sent a certain amount of a certain title, for instance, and the receiver agrees they have received it") without any use of the watermark. At a certain time, or threshold, a liability to pay for the information incurs. If the parties disagree, before this threshold is reached, the transaction can be discontinued, implying that a transaction has begun at some prior time. However, both sides must agree as to what a watermark says (column 9, lines 20-21). If they do agree, then information may continue to be transferred after the threshold time. Therefore, while the watermark might not have been used to initiate the content delivery from the very beginning of the communication, one can reasonably interpret, in our view, the time immediately following the threshold time as a new initiation of information transfer because if the parties do not agree as to what the watermark says by the time of the threshold, data content transfer ends there. But, when the parties do agree, content transfer is permitted to continue past the time of the threshold.

Therefore, one may reasonably interpret the watermark as *initiating* delivery of the information from the time of the threshold, when the parties agree. If it were not for the watermark and for agreement of the parties, information is discontinued at the threshold point. But, because of the watermark, and the agreement of the parties as to what the watermark says, information is permitted to continue, i.e., to initiate from the threshold time. Accordingly, as broadly claimed, we view Moskowitz, as did the examiner, to describe a networked computer system, responsive to watermark data sent from a remote client application to initiate delivery of audio or video data, as claimed. We note that appellants do not dispute the type of data delivered by the Moskowitz system.

We also note that the claimed "remote client application" is a relative term and, in Moskowitz, such a remote client application could be either the sending unit or the receiving unit. If the sending unit, then the watermark data that is sent from that unit to the receiver initiates delivery of the data.

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If the receiving unit is considered the remote client application, then the agreement with, and sending back the digital signature, along with watermark data, to the sender causes an initiation of the delivery of the data, as noted supra.

Thus, we will sustain the rejection of claim 13 under 35 U.S.C. § 102(e).

Claim 14 further limits claim 13 in requiring that the watermark data is sent from a software program on a remote computer and that the delivery of the audio or video data is initiated to that same remote computer.

The examiner points to column 8, lines 66-67, of Moskowitz for the limitations of claim 14. This portion of Moskowitz does indicate that watermarks can be generated to contain certain information to be used in effecting software. Clearly, watermark data itself is sent from some software program.

Appellants argue that, in Moskowitz, the watermark data is not sent from a software program on a remote computer and that the delivery of the audio or video data is initiated to that same remote computer. We disagree.

If the receiver is considered the "remote computer" in Moskowitz, at the time the receiver agrees to the terms and returns a digital signature along with watermark data (the digital signature must either be part of, or returned with some portion of data related to, the watermark so that the sender knows what the digital signature is related to), this is watermark data sent from software on the remote computer. When the sender receives this digital signature along with the watermark data, it will "initiate" (or continue to send, as noted supra) delivery of the data to the receiver, or remote computer. Thus, in Moskowitz, watermark data is sent from the remote computer and delivery of the data is initiated to that same remote computer, as claimed.

Thus, we will sustain the rejection of claim 14 under 35 U.S.C. § 102(e).

With regard to independent claim 7, the examiner indicates that Doyle embeds a tag within a html document "wherein the tag is indicative of a file context or format or a program identifier, i.e., identifying a program for use to open or operate upon the document at the remote system," (answer-page 4), pointing to column 12, line 54, through column 13, line 31, of Doyle.

The examiner recognized that Doyle lacks a teaching of using watermark data in the contents, but relied on Moskowitz for the teaching of using watermark data in a file for enabling transfer of a copyrighted document.

The examiner concluded that it would have been obvious to utilize Moskowitz's teaching in Doyle because it would have "enabled distributing copyrighted contents to a plurality of users in the network more effectively (see Moskowitz in col. 2, line 56 - col. 3, line 3)" (answer-page 5).

Appellants argue that Doyle does not teach a "software program, operable to transmit...an identifier of said software program," as required by claim 7. That is, appellants argue, Doyle does not teach a software program that transmits an identifier "of itself," as specified in the claim. Appellants point out that Doyle merely discloses a hypertext markup language document that includes a tag specifying whatever program is required to view or act upon a file found at a specified URL, but the tag does not specify the program that transmits the identifier.

Moreover, contend appellants, even if Doyle had the deficiencies which appellants contend it does not, the examiner's rationale for making the combination of Doyle and Moskowitz is insufficient in that there is no reference to any problem with Doyle's system for which Moskowitz proposes a solution and the two references are not even in the same field of endeavor.

The examiner does not disagree with appellants' interpretation of Doyle, but argues that claim 7 does not specify that the software program transmits the packet of data, contending that "operable to transmit" may modify "apparatus" which may contain more elements than the software program (see page 7 of the answer).

We would agree with appellants that Doyle does not teach a software program that transmits an identifier "of itself." However, as broadly claimed, we agree with the examiner that it is not necessarily the software program that transmits the packet of data. That is, one can reasonably read claim 7 as requiring an "apparatus" which includes a watermark detector and a watermark-related software program, and that it is the "apparatus" that is "operable to transmit a packet of data."

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Thus, as written, the claim may be interpreted in a different manner than the software program transmitting the packet of data.¹

With our interpretation of the claim in mind, Doyle does describe an apparatus that allows a program to execute on a remote server (see lines 17-19 of the abstract). This means that the apparatus had to have transmitted some packet of data to permit the execution of the program on the remote server.

Having said all this, however, we agree with appellants that no prima facie case of obviousness has been established by the examiner because we find no reason for the skilled artisan to have contemplated combining Moskowitz's teaching regarding watermarks with Doyle's distributed hypermedia system. We agree with appellants that, other than hindsight, there would have been no reason to apply any teachings of using watermarks to Doyle. As appellants point out, there would appear to be no evidence of a problem in Doyle which the application of watermarks would

¹ Because of the possibility of two interpretations, there may be a problem with the claim under 35 U.S.C. §112, second paragraph.

solve. The examiner's mere general reference to "more effectively" enabling distribution of copyrighted contents to a plurality of users in the network smacks more of hindsight than a reason under 35 U.S.C. § 103 for combining the teachings of the references. There is no hint in Doyle that Doyle is even dealing with copyrighted material.

Thus, we will not sustain the rejection of claim 7, or of claims 8 and 9 dependent thereon, under 35 U.S.C. § 103.

For reasons similar to those supra with regard to claim 7, we also will not sustain the rejection of claim 10, or of claims 11 and 12 dependent thereon, under 35 U.S.C. § 103.

Regarding claims 15 and 16, the examiner contends that Monteiro discloses a system for delivering multimedia contents including advertisements and update software to users, pointing to column 7, lines 60-65, and column 11, lines 46-67, of Monteiro.

Recognizing that Monteiro lacks a teaching of the use of watermark data in the contents, the examiner once again turns to Moskowitz, and concludes that it would have been obvious to make

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the combination because "it would have enabled distributing copyrighted contents to a plurality of users in the network more effectively (answer-page 6).

We will not sustain the rejection of claims 15 and 16 under 35 U.S.C. § 103. For the reasons supra, with regard to the rejection of claim 7, we find that there would have been insufficient motivation, based on the examiner's reasoning, to combine the references. Moreover, we agree with appellants' analogy of the instant claim language to the claimed remote computer being both the "pitcher" and the "catcher" (reply brief-page 13). The instant claims require the remote computer to send the watermark data and also receive the delivery of the information (advertisement or updated software). The examiner has shown no such dual function in the applied references.

CONCLUSION

We have sustained the rejection of claims 13 and 14 under 35 U.S.C. § 102(e), but we have not sustained the rejection of claims 7-12, 15, and 16 under 35 U.S.C. § 103.

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Accordingly, the examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 C.F.R.
§ 1.136(a)(1)(iv).

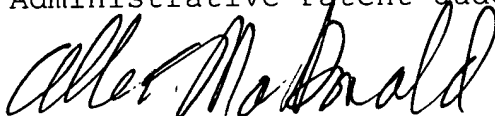
AFFIRMED-IN-PART



ERROL A. KRASS)
Administrative Patent Judge)



HOWARD B. BLANKENSHIP)
Administrative Patent Judge)



ALLEN R. MACDONALD)
Administrative Patent Judge)

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